

REMARKS

In the outstanding office action, claims 10, 11, 16, 17 and 35 are rejected under 35 USC §§ 102, 103 and 112. The applicants respectfully traverse each of these rejections. Accordingly, claims 10, 11, 16, 17 and 35 remain pending and at issue.

First with respect to the written description rejection under §112, the applicants disagree with the Examiner that no support is provided in the specification for the water and starch forming an adhesive. The specification is replete with references to a water supply and a starch supply which combine to form an adhesive. Moreover, such a combination is readily known by anyone in the industry and is of such common understanding as to suggest the Examiner is not completely aware of the nuances of corrugating industry. As a result, applicants enclose a declaration under 37 CFR 1.132.

But with respect to the teachings of the specification, the applicants turn the Examiner's attention to such examples as page 1, lines 6-10, wherein it states;

"in particular, a starch slurry is prepared as one of ordinary skill in the art will readily recognize using mainly powdered starch and water."

Page 2, lines 3-12, state among other things that;

"if the process is operating at a rate that is too slow, virtually all of the water from the starch slurry is absorbed after the slurry is applied to the flute tips and prior to the slurry becoming an adhesive. Water from the starch slurry is absorbed into the fluting paper after the slurry is applied and before the slurry becomes an adhesive."

In the detailed description on page 8, line 3, the wetting agent 240 is defined as water while the adhesive supply device 116 is defined as providing an adhesive composition, which in turn is defined further in that paragraph as a;

"starch composition which may be a starch slurry produced from maize starch, wheat starch, potato starch, tapioca and other vegetable starch."

Describing the actual process of applying such materials to the web, page 10, states;

"At a step 520, a wetting agent such as water with or without additives is applied to a plurality of crests on the first side of the first web. At a step 530, an adhesive composition such as a starch slurry is applied to the plurality of crests on the first side of the first web after the wetting agent is applied at step 520. The adhesive composition such as starch slurry is prepared as one of ordinary skill in the art will readily recognize. For example, the starch slurry may be heated to a temperature such that the powdered starch granules burst, gelatinize, and form a glue."

Based on these teachings, as well as others provided throughout the specification, the applicants are at a loss as to how the Examiner can conclude that separate water and starch supplies which combine to form an adhesive is not disclosed in the pending specification and thus request that such rejection be withdrawn.

Turning to the prior art rejections, the arguments previously submitted remain the same as reiterated herein, and supplemented by an inventor's declaration under 37 C.F.R. §132. In addition, in response the brief reasoning the Examiner gives at the end of the outstanding office action as to why the previous arguments were not persuasive, applicants provide specific responses below.

First, the claims were rejected as anticipated by Wallick, U.S. Patent No. 5,292,391 or 5,332,458. Applicants previously argued that Wallick does not provide separate water and starch supply devices. Surprisingly, and in contradiction to established patent law, the Examiner stated that the resin applicator of Wallick is the same as the water supply device claimed. This type of leap is simply impermissible. The law of anticipation is clearly established as requiring that a single prior art reference must disclose each and every element of a pending claim.¹ The Examiner is not allowed to contribute further teaching to a reference which is not there. The anticipation standard is one of strict identity, and if the

¹ Anticipation under 35 USC §102 requires the disclosure in a single piece of prior art of each and every limitation of a claimed invention. "Rockwell International Corp. v. United States 47 USPQ2d 1027 (Fed. Cir. 1998).

element is not present in a reference, the anticipation rejection must fail. Any differences between the teachings of a single prior art reference and the claimed subject matter, immediately requires the rejection to at best be an obviousness rejection. However, as we are talking about anticipation, clearly those rejections have been overcome and the Examiner should withdraw them.

With regard to the obviousness rejections, the Examiner is still required to show that the combined references disclose or suggest each and every element of the pending claims.² Again, the Examiner is not allowed to take liberties with respect to those teachings but must specifically show them, and if they are not present, to not make the rejection. As stated above, the Wallick references do not disclose many of the pending elements. This is tacitly admitted by the Examiner, but conveniently disregarded by arguing that the present applicator of Wallick is "considered to be a water supply device". With respect to Swift, which was previously argued as being inapplicable and is now used as part of an obviousness rejection, the Examiner again provides a weak rejection by conveniently arguing that the spraying device 6 of Swift is "capable of supplying water". However, this is not sufficient for an obviousness rejection, what the Examiner must do is find references which disclose or suggest each of the elements of the pending claim, and then provide reasoning as to why one of ordinary skill in the art would be motivated to combine those elements to arrive at the pending claim. Here, the Examiner does neither. Most problematically, she fails to provide any reference which teaches each and every element of the pending claims. Without that, clearly she can not provide any motivation as to why one of ordinary skill in the art would combine elements which are not even present in the first place. Accordingly, the obviousness rejection should be withdrawn as well, either now, or should the Examiner wish, before the Appeal Board if needed.

Even above and beyond these differences and failures in the prior art to disclose or suggest specific elements of the pending claims, the Examiner appears not to grasp to the main point, which is that not only are there structural differences between the

² To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." MPEP §2143

pending claims and that of the prior art, but the resulting combination results in a significant improvement in the industry. In other words, these differences are not merely pointed out so as to provide a technical mechanism by which the anticipation and obviousness rejections can be overcome, but as a way of clarifying how the pending application is a significant contribution to the art and thus even more clearly novel and not obvious. In this regard, applicants refer the Examiner's attention to the enclosed declaration under 37 C.F.R. §132 wherein the inventor, a person of considerable expertise in this field, and a multiple patentee in the corrugating arts as well, points out the genesis for this invention, and the key contributions it makes to the corrugation field.

In light of all the foregoing, applicants respectfully submit that each of the pending claims is in condition for allowance and respectfully requests same. Should the Examiner have any questions, she is invited to telephone the undersigned.

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Respectfully submitted,

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